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10/091,038	03/05/2002	Teemu Puskala	042933/319824	8149

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EXAMINER

THOMASSON, MEAGAN J

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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12/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/091,038

Applicant(s)

PUSKALA, TEEMU

Examiner

Meagan Thomasson

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The examiner acknowledges the amendments made to claims 16,31 and 43.

Claim Objections

Claim 43 is objected to because of the following informalities: Claim 43 is currently labeled as "Previously Presented". Claim 43 has been amended, and should therefore be labeled as "Amended". Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12,14-50 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-60 of U.S. Patent No. 6,908,389. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of U.S. Patent No. 6,908,389 (herein referred to as '389) are substantially similar to those of the instant application in that they comprise a system and method for enhancing communication on a wireless network using predefined messages comprising a service platform, transmitting means for transmitting certain content to a user of a wireless terminal, providing means for providing at least one content-related predefined message to the user of the wireless terminal, at least one wireless terminal for receiving the certain content and the at least one content-related predefined message, selecting means for enabling the user of the wireless terminal to transmit the content-related predefined message, and transmitting means for transmitting the content-related predefined message to at least one address selectable by the user.

The conflicting claims are not identical in that the claims of '398 are drawn to providing gaming content, while the claims of the instant application are drawn to providing "certain content", as recited in claim 1. The scope of the claims in the instant application encompasses the gaming content of '398, and thus the claims are not patentably distinct.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-12,14-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackintosh et al. (US 6,317,784 B1) in view of Sivula (US 6,795,711 B1).

Regarding claims 1,16,41-46,49 Mackintosh discloses a system for enhancing communication on a wireless network using predefined messages, comprising a service platform running an on-line service, the on-line service for providing a certain content (Fig. 5, Broadcast internet service provider), the service platform comprising transmitting means for transmitting the certain content to a user of at least one wireless terminal, referred to by Mackintosh as broadcast material where broadcast material may include music tracks, advertising tracks, etc. (col. 2, line 42-col.3, line 16), and providing means for providing along with the transmitted certain content at least one content-related predefined message to the user of the at least one wireless terminal based upon the certain content, the message being generated independently of the certain content

and automatically modified based on an identity of the certain content. Specifically, Mackintosh discloses the ability to deliver content, i.e. a music track, in combination with a content-related predefined message (col. 3, lines 42-67) to a user terminal via a wireless communication system (col. 24, line 55 - col. 25, line 4). Referring to Fig. 12, the content-related predefined message comprises the information fields "artist", "song", "album" and album cover (field **518**) that are generated independently of the certain content and automatically modified based on an identity of the certain content. These fields are predefined and generated independently of the certain content, as they are displayed to the player irrespective of the track being played, but are modified to include data pertinent to the track currently being played.

Mackintosh does not specifically disclose the at least one wireless terminal further comprises selecting means for enabling selecting, by the user of said at least one wireless terminal, whether to transmit one or more of the provided at least one content-related predefined messages wirelessly from said at least one wireless terminal, and transmitting means for transmitting, if the user of said at least one wireless terminal selects to transmit one or more of the provided content-related predefined messages, the selected content-related message to at least one address selectable by the user of said at least one wireless terminal. However, Mackintosh does disclose a communications interface "that allows software and data to be transferred between computer system **702** and external devices", wherein this "can be implemented using a wireless medium" including a cellular phone link (col. 24, line 55 - col. 25, line 4). Additionally, Sivula discloses an analogous message content delivery system wherein a

user may utilize a wireless phone comprising selecting means for enabling selecting by the user of said wireless phone whether to transmit content including a content-related message from said wireless terminal as well as transmitting means for transmitting the content and related pre-defined message to at least one address selectable by the user of said at least one wireless terminal (col. 6, lines 20-27). The ability to forward messages among cell phone users, e.g. "text messaging", is well known to one of ordinary skill in the art. Further, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Mackintosh and Sivula as Mackintosh discloses the ability to communicate with external devices via a cellular phone link, as discussed above. All of the claimed elements were known, i.e. providing content and content-related predefined messages to a user of a wireless device and the ability to forward messages among users of wireless devices including cellular phones, at the time of the invention and could have been combined by one of ordinary skill in the art in order to produce predictable results.

Regarding claims 2-4,17-20 wherein the at least one address selectable by the user comprises a predetermined address of at least one other wireless terminal, the invention disclosed by Sivula features wireless phones such that a user may select or enter the telephone number, i.e. address, of the intended recipient.

Regarding claims 5,21, the at least one other terminal comprises a wireless terminal (Sivula, abstract).

Regarding claims 6,22,32 Sivula discloses means for assessing an output capability of said at least one other terminal to receive the predefined message, and

means for configuring the predefined message, prior to transmitting the predefined message to the address of the at least one other terminal, so that the output capability of the at least one other terminal to receive the predefined message is taken into consideration (col. 9, lines 46-57).

Regarding claims 7,23,47 Mackintosh discloses the providing means comprises a content determining means for determining the content of the online service ("cut number" col. 9, lines 8-34).

Regarding claims 8,12,24,27 Mackintosh discloses said providing means receives a predefined criteria and generates or selects the predefined message based upon the predefined criteria. That is, Mackintosh discloses the cut number provides information relating to the type of cut, i.e. content, including any of music, ad traffic, EJ segments, etc (col. 9, lines 10-25). If the identified content is a music track, the predefined message will contain information fields such as song, album title, etc., as discussed above with respect to claim 1. If the content is an advertisement segment, the predefined message will contain information fields such as company logos, product pictures, etc., (col. 13, lines 16-22), wherein said fields are automatically modified (i.e. filled in) based upon the advertising segment content.

Regarding claims 9,25,34 Sivula discloses both terminals are mobile phones (abstract).

Regarding claims 10,35 wherein the at least one wireless terminal comprises a dedicated button to cause the content-related predefined message to be transmitted to

the selected address, the "Send" button on any cellular phone acts as a dedicated button to begin a transmission.

Regarding claims 11,26 Sivula discloses an indicator to be displayed to indicate that at least one content-related predefined message is available for selection (col. 10, lines 8-12).

Regarding claims 14,28 Mackintosh discloses the predefined message is stored in and retrieved by the providing means from a storage device in the service platform (Fig. 1).

Regarding claims 15,30,38 Mackintosh discloses the predefined message comprises at least one of voice, text, sound, an image, a picture and a video (Fig. 12).

Regarding claims 39,40 wherein the on-line service comprises at least one of an Internet web site and a network server providing at least one of an interactive program and streaming audio and/or video (Mackintosh, col. 8, lines 33-65).

Regarding claim 31, in addition to the invention described above, Sivula discloses the wireless terminal comprises a processor in communication with a data storage device, a primary input in communication with the processor, and an interactive program operative on the processor (col. 9, lines 15-22).

Regarding claim 33,47, see claims 39 and 8 above.

Regarding claims 36 and 37, Sivula discloses the storage device may be located in the wireless terminal (col. 9, lines 15-20) as well as located in a service platform (col. 8, lines 28-44).

Regarding claims 48 and 50, Sivula discloses the service platform has a communication link with the content provider (Fig. 1 and 3).

Response to Arguments

Applicant's arguments, see Remarks P. 12-13, filed October 9, 2007, with respect to the 35 U.S.C. 112, second paragraph, rejection of claim 1 have been fully considered and are persuasive. The rejection of claim 1 under 35 U.S.C. 112, second paragraph, has been withdrawn.

Applicant's arguments, see Remarks P. 13-16, filed October 9, 2007, with respect to the rejection(s) of claim(s) 1-50 under 35 U.S.C. 102(2) as being anticipated by Sivula have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Mackintosh et al. (US 6,317,784 B1) and Sivula (US 6,795,711 B1). Specifically, the examiner agrees that Sivula does not disclose the limitation of claim 1 wherein the modifications to the content-related predefined message are based on an identity of the content.

Applicant's arguments filed October 9, 2007 with respect to the non-statutory double patenting of claims 1-50 in light of U.S. Patent No. 6,908,389 have been fully considered but they are not persuasive. P. 16 of applicant's remarks state that "Applicant is submitting herewith a terminal disclaimer", however no such terminal disclaimer has been filed. Therefore, the examiner maintains the non-statutory type double patenting rejection of claims 1-50.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meagan Thomasson whose telephone number is (571) 272-2080. The examiner can normally be reached on M-F 830-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Meagan Thomasson
December 18, 2007


XUAN M. THAI
SUPERVISORY PATENT EXAMINER